

REMARKS

The Office has required restriction to one of the following groups of inventions under 35 U.S.C. § 121:

Group I: claims 1-21, drawn to a tunneler, classified in class 623, subclass 1.11; and

Group II: claims 22-25, drawn to a method for using a tunneler with a catheter, classified in class 604, subclass 528.

The Office argues that Groups I and II are related as a product and process of use. The Office alleges that the inventions of these two groups are distinct since the product as claimed can be used in a materially different process of using that product, i.e., the tunneler can be used with a single lumen catheter rather than the claimed multi-lumen catheter.

Applicant elects, with traverse, to prosecute the invention of Group I, claims 1-21. Applicant's traversal is on the grounds that the Office has not substantiated that any restriction between the claims of Group I and Group II is warranted.

To begin with, the Office has not even shown—or less alleged—that the claims for Groups I and Group II are independent. 35 U.S.C. § 121 requires that for restriction to be proper, the Office must show that groups of claims are both independent and distinct. *See also M.P.E.P. §§ 802; 802.01.* The Office, however, has only alleged that the claims are distinct for these reasons given on page 2 of the Office Action.

The Office can still require restriction where only distinctness has been argued, provided that the Office shows that there is a serious burden on the Examiner. *See M.P.E.P. § 803.* But

the Office has not argued that there exists a serious burden, i.e., by substantiating that the groups of claims have acquired a separate status in the art as shown by their different classification.

Applicant also disagrees that the Office has shown that the invention of Group I can be used in the proposed other and “materially different” process. The proposed materially different process is one that uses a single lumen catheter. Claims 1-21, however, contain the limitation that the tunneler contains a plurality of shaft members with different lengths. But Applicant fails to understand how a tunneler with a plurality of shaft members with different lengths could be used with a single-lumen catheter. It seems that it would be extremely difficult—if not impossible—to fit first one shaft member and then another shaft member into the exact same lumen. Thus, the process proposed by the Office is not a feasible “materially different” process and the Office, therefore, has not substantiated that groups of claims are distinct.


Accordingly, the Office has not established a proper restriction requirement between Groups I and II. Applicant therefore requests withdrawal of this restriction requirement and examination of all pending claims.

CONCLUSION

For the above reasons, Applicant respectfully requests the Office to withdraw the restriction requirement and examine all the pending claims.

If there is any fee due in connection with the filing of this Response, including a fee for any extension of time not accounted for above, please charge the fee to our Deposit Account No. 50-0843.

Respectfully Submitted,

By 
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